

REMARKS

The following remarks are provided in response to the Final Office Action dated April 27, 2004 in which the Examiner:

- rejected claims 1-2, 4-7, 9-10, 13, 25, 27-29, and 31-34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Misra et al. (hereinafter Misra) in view of Gradient, “Gradient Introduces End User Software License Creation and Delivery Tool for its iFOR/LS Licensing Technology,” dated March 21, 1994 (hereinafter Gradient) and U.S. Patent No. 5,708,709 to Rose.

The applicant respectfully requests reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully requests that the Examiner withdraw all rejections.

New Claims

The applicant herein adds claims 35-41 and respectfully submits that he has the right to claim the invention as set forth in new claims.

35 U.S.C. §103(a)

The Examiner rejected claims 1-2, 4-7, 9-10, 13, 25, 27-29, and 31-34 under §103(a) as being unpatentable over Misra in view of Gradient and Rose. For at least the foregoing reasons the applicant traverses the Examiner’s rejection.

A *prima facie* case of obviousness under 35 U.S.C. §103 requires, among other criteria, that “. . . the prior art reference (or references when combined) must teach or suggest **all** the claim limitations.” (emphasis added) (See M.P.E.P. 706.02(j) and

2143.03). To overcome a §103(a) rejection, the applicants must only demonstrate that the cited prior art document or documents fail individually and in combination to teach or suggest one element or limitation present in the claim.

The salient portion of currently amended independent claim 1 recites:

. . . generating, on a local computer, an install license for software installed on the local computer in response to the software being installed;
obtaining, by the local computer **in response to generating the install license**, from a remote computer a trial license for the installed software, wherein the trial license is generated by the remote computer; . . .
(emphasis added)

Currently amended independent claim 13 recites a similar limitation. The Examiner notes that Misra fails to specifically disclose that the install license is being replaced by a trial license. The applicant agrees. The Examiner alleges, however, that Rose column 11 lines 3-15 disclose later replacing an original trial license with another trial license. The Examiner further alleges that the first trial license taught by Rose is equivalent with the install license recited by currently amended independent claim 1. The applicant disagrees. The applicant submits that Rose column 11 lines 3-11 disclose a trial version of an Application Program licensed by a trial license and that the Application Program may thereafter be licensed by additional trial licenses. The applicant asserts that the cited portions of Rose fail to disclose generating, on a local computer, an install license for software installed on the local computer in response to the software being installed and obtaining, by the local computer in response to generating the install license, from a remote computer a trial license for the installed software. In particular, Rose teaches **multiple instances of equivalent trial licenses** contrary to an **install license** and a **trial license** as recited by currently amended independent claim 1. The applicant affirms that

the Examiner admits that the function of the install license is different than the function of the trial license (See April 29, 2004 Office Action at page 5, lines 21-22); therefore, **the Examiner cannot properly conclude that the install license recited in currently amended independent claim 1 is “essentially equivalent” to a trial license.** Accordingly, the applicant submits that currently amended independent claims 1 and 13 are patentable as each recites at least an element not taught by Misra in view of Gradient and Rose.

As dependent claims 2, 4-7, 9-10, 25, 27-29, and 31-34 depend from nonobvious independent claims, the dependent claims are also nonobvious. (See M.P.E.P. §2143.03 (citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988))).

CONCLUSION


For at least the foregoing reasons, the applicant submits that he has overcome the Examiner's rejections and he has the right to claim the invention as set forth in the listed claims. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN, L.L.P.

11/26/04
Dated _____


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